

## **REMARKS**

This response addresses the Office Action dated July 12, 2007. Claims 1-25 are pending. Claims 21-25 have been withdrawn from consideration pursuant to a restriction requirement.

### **Rejection under 35 U.S.C. § 112**

The Examiner rejected claims 2-18 under 35 U.S.C. § 112, second paragraph, as being indefinite.

#### *Claim 2*

As the Examiner notes, independent apparatus claim 1 recites a prosthesis to replace all or a portion of a caudal portion of a natural facet joint on a vertebral body comprising a prosthesis body accommodating fixation to the vertebral body at or near a pedicle and without support by a lamina, and an artificial facet joint structure carried by the prosthesis body adapted and configured to replace all or a portion of a caudal portion of a natural facet joint. Claim 2 depends from claim 1 and further limits the structure recited in claim 1 by requiring that the artificial facet joint structure be adapted and configured to replace a natural articular process of a caudal portion of a natural facet joint.

The Examiner appears to make two different arguments in support of his rejection. First, the Examiner states that “it is not clear how the structure of the device is further defined . . . by the function of ‘adapted and configured to replace a natural articular process.’” (Office Action, p. 3). The meaning of this limitation, however, is clear from a comparison of the language of the two claims. In claim 1, the prosthesis is adapted and configured to replace *all or a portion of a caudal portion of a natural facet joint*. Claim 2 is more limited: The prosthesis of claim 2 is adapted and configured to replace *a natural articular process* of a caudal portion of a natural facet joint. A skilled artisan would understand that a natural articular process of a caudal portion of a facet joint (as recited in claim 2) is different than all or a portion of a caudal portion of a natural facet joint (as recited in claim 1). This reason for the Examiner’s rejection of claim 2 therefore cannot sustain a rejection under § 112, second paragraph.

The Examiner’s second reason is that “the structure as set forth in claim 1 and as illustrated in figure 36 is not further modified by the method steps of claim 2.” Claim 2 is an

apparatus claim, however, not a method claim. This portion of the Examiner's rejection therefore makes no sense and appears to be an error. Applicant respectfully requests the Examiner to either clarify or withdraw this portion of his rejection in order to provide a better record for appeal.

For the reasons stated above, claim 2 meets the requirements of § 112, second paragraph. Applicant respectfully requests the Examiner to withdraw his rejection of claim 2 under § 112.

*Claims 3-18*

While the Office Action states that claims 3-18 are rejected under § 112, second paragraph, the Examiner does not explain or state any basis for the rejection of these claims. In fact, these claims meet the requirements of § 112. Applicant respectfully requests the Examiner to either withdraw the rejection of these claims or state the basis of his rejection of these claims in a new non-final rejection so that Applicant will have an opportunity to respond to the rejection on the record to complete the record for appeal.

**No Rejection of Claims 1, 19 and 20**

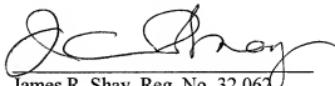
While the cover sheet of the Office Action indicates that claims 1, 19 and 20 have been rejected, the body of the Office Action does not state the statutory basis for the rejection of these claims. Applicant respectfully requests the Examiner to either withdraw the rejection of these claims or state the basis of his rejection of these claims in a new non-final rejection so that Applicant will have an opportunity to respond to the rejection on the record to complete the record for appeal.

**CONCLUSION**

For the reasons stated above, claims 1-20 meet the formal requirements of § 112. These claims are also patentable over the prior art of record. Applicant therefore requests reconsideration and allowance of claims 1-20. If a telephone conference would expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Respectfully submitted,

By:



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